

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Confirmation Number: 7194

Daniell, W. Todd

Group Art Unit: 2179

Serial No.: 10/686,344

Examiner: Osberg, Thuy Thanh

Filed: October 14, 2003

Docket No. 190250-1600

For: **Options Associated with Instant Messaging (IM) Chat Transcripts of IM Chat Sessions**

RESPONSE

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request consideration of the following remarks contained herein in response to the Office Action mailed May 29, 2007. Applicants respectfully submit that the remarks contained herein place the instant application in condition for allowance.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 20-0778.

CLAIMS

The following is a courtesy copy of the claims, indicating that no amendments are currently made.

1. (Previous Presented) A method for saving a transcript of instant messaging (IM) chat sessions, the method comprising:

providing an email compose interface for composing an email message, the email compose interface configured to designate at least one email recipient, the email compose interface including an email send option for sending the email message to the email recipient, the email compose interface including an IM launch option for launching an IM chat session with the at least one recipient of the email message;

receiving an indication to launch an IM chat session with the at least one email recipient of the email message from the email compose interface;

receiving an indication to save an IM chat transcript of the IM chat session; and

saving the IM chat transcript in response to receiving the indication to save the IM chat transcript.

2. (Previously Presented) The method of claim 1, further comprising:

receiving an indication to terminate the IM chat session prior to receiving the indication to save the IM chat transcript;

providing a prompt in response to receiving the indication to terminate the IM chat session, the prompt comprising:

an indication to save the IM chat transcript; and

an indication to not save the IM chat transcript;

wherein receiving the indication to save the IM chat transcript is responsive to providing the prompt.

3. (Previously Presented) The method of claim 1, wherein saving the IM chat transcript comprises:

saving the IM chat transcript as an IM chat window.

4. (Original) The method of claim 3, wherein the IM chat window comprises a record of IM events, the IM events being selected from a group consisting of:

a list of participants in the IM chat session;

IM text messages from the participants;

files transferred during the IM chat session; and

a combination thereof.

5. (Previously Presented) The method of claim 3, further comprising:

converting the IM chat transcript to a text file.

6. (Previously Presented) The method of claim 3, further comprising:

converting the IM chat transcript to an email message.

7. (Previously Presented) The method of claim 1, wherein saving the IM chat transcript comprises the step of:

saving the IM chat transcript as text file.

8. (Previously Presented) The method of claim 1, wherein saving the IM chat transcript comprises:

saving the IM chat transcript as an email message.

9. (Previously Presented) A computer-readable storage medium encoded with instructions for execution, comprising:

computer-readable code adapted to instruct a programmable device to provide an email compose interface for composing an email message, the email compose interface configured to designate at least one email recipient, the email compose interface including an email send option for sending the email message to the email recipient, the email compose interface including an IM launch option for launching an IM chat session with the at least one recipient of the email message;

computer-readable code adapted to instruct a programmable device to receive an indication to launch an IM chat session with the at least one email recipient of the email message from the email compose interface;

computer-readable code adapted to instruct a programmable device to receive an indication to save an IM chat transcript of the IM chat session; and

computer-readable code adapted to instruct a programmable device to save the IM chat transcript in response to receiving the indication to save the IM chat transcript.

10. (Previously Presented) The computer-readable storage medium of claim 9, further comprising:

computer-readable code adapted to instruct a programmable device to receive an indication to terminate the IM chat session prior to receiving the indication; and

computer-readable code adapted to instruct a programmable device to provide a prompt in response to receiving the indication to terminate the IM chat session, the prompt comprising:

an indication to save the IM chat transcript; and

an indication to not save the IM chat transcript.

11. (Previously Presented) The computer-readable storage medium of claim 9, further comprising:

computer-readable code adapted to instruct a programmable device to save the IM chat transcript as an IM chat window.

12. (Previously Presented) The computer-readable storage medium of claim 11, further comprising:

computer-readable code adapted to instruct a programmable device to convert the IM chat transcript to a text file.

13. (Previously Presented) The computer-readable storage medium of claim 11, further comprising:

computer-readable code adapted to instruct a programmable device to convert the IM chat transcript to an email message.

14. (Previously Presented) The computer-readable storage medium of claim 9, further comprising:

computer-readable code adapted to instruct a programmable device to save the IM chat transcript as text file.

15. (Previously Presented) The computer-readable storage medium of claim 9, further comprising:

computer-readable code adapted to instruct a programmable device to save the IM chat transcript as an email message.

16. (Previously Presented) A system for saving a transcript of instant messaging (IM) chat sessions, the system comprising:

means for providing an email compose interface for composing an email message, the email interface configured to designate at least one email recipient, the email compose interface including an email send option for sending the email message to the email recipient, the email compose interface including an IM launch option for launching an IM chat session with the at least one recipient of the email message;

means for receiving an indication to launch an IM chat session with the at least one email recipient of the email message from the email compose interface;

means for receiving an indication to save an IM chat transcript of the IM chat session;
and

means for saving the IM chat transcript in response to receiving the indication to save the IM chat transcript.

17. (Previously Presented) A system for saving a transcript of instant messaging (IM) chat sessions, the system comprising:

a provide component configured to provide an email compose interface for composing an email message, the email compose interface configured to designate at least one email recipient, the email compose interface including an email send option for sending the email message to the email recipient, the email compose interface including an IM launch option for launching an IM chat session with the at least one recipient of the email message;

a first receive component configured to receive an indication to launch an IM chat session with the at least one recipient of the email message from the email compose interface;

a second receive component configured to receive an indication to save an IM chat transcript of the IM chat session; and

a save component configured to save the IM chat transcript in response to receiving the indication to save the IM chat transcript.

18. (Previously Presented) The system of claim 17, further comprising:

a terminate-receive configured to receive an indication to terminate the IM chat session prior to receiving the indication; and

a prompt component configured to provide a prompt in response to receiving the indication to terminate the IM chat session, the prompt comprising:

an indication to save the IM chat transcript; and

an indication to not save the IM chat transcript.

19. (Previously Presented) The system of claim 17, wherein the save component further comprises:

an IM-save component configured to save the IM chat transcript as an IM chat window.

20. (Previously Presented) The system of claim 19, further comprising:

a text-convert component configured to convert the IM chat transcript to a text file.

21. (Previously Presented) The system of claim 19, further comprising:

an email-convert component configured to convert the IM chat transcript to an email message.

22. (Previously Presented) The system of claim 17, wherein the save component further comprises:

a text-save component configured to save the IM chat transcript as text file.

23. (Previously Presented) The system of claim 17, wherein the save component further comprises:

an email-save component configured to save the IM chat transcript as an email message.

REMARKS

Applicants respectfully request consideration of the following remarks contained herein in response to the Office Action mailed May 29, 2007. Applicants respectfully submit that the remarks contained herein place the instant application in condition for allowance.

Upon entry of this response, claims 1 – 23 are pending. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

I. Rejections Under 35 U.S.C. §103

A. Claim 1 is Allowable Over *Ertugrul* in view of *Lehman*

The Office Action indicates that claim 1 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over of U.S. Publication Number 2002/0087645 ("*Ertugrul*") in view of Wayback machine:

<http://web.archive.org/web/19970125101157/http://www.albion.com/ngmsn/07chat-sample.html> ("*Lehman*"). Applicants respectfully traverse this rejection for at least the reason that *Ertugrul* in view of *Lehman* fails to disclose, teach, or suggest all of the elements of claim 1. More specifically, claim 1 recites:

A method for saving a transcript of instant messaging (IM) chat sessions, the method comprising:

providing an ***email compose interface for composing an email*** message, the email compose interface configured to designate at least one email recipient, the email compose interface including an email send option for sending the email message to the email recipient, the email compose interface including an ***IM launch option for launching an IM chat session with the at least one recipient of the email message***;

receiving an indication to launch an IM chat session with the at least one email recipient of the email message from the email compose interface;

receiving an indication to save an IM chat transcript of the IM chat session; and

saving the IM chat transcript in response to receiving the indication to save the IM chat transcript.

(emphasis added)

Applicants respectfully submit that claim 1 is allowable for at least the reason that *Ertugrul* in view of *Lehman* fails to disclose, teach, or suggest a “method for saving a transcript of instant messaging (IM) chat sessions, the method comprising... providing an **email compose interface for composing an email** message, the email compose interface configured to designate at least one email recipient, the email compose interface including an email send option for sending the email message to the email recipient, the email compose interface including an **IM launch option for launching an IM chat session with the at least one recipient of the email message**” as recited in claim 1. More specifically, *Ertugrul* discloses “FIG. 2 illustrates the body of a representative email message 200 received by an email recipient” (page 3, paragraph [0034]). For at least the reason that *Ertugrul* fails to disclose “providing an **email compose interface for composing an email** message... the email compose interface including an **IM launch option for launching an IM chat session with the at least one recipient of the email message**” claim 1 is allowable.

Applicants additionally submit that *Ertugrul* fails to even suggest “providing an **email compose interface for composing an email** message... the email compose interface including an **IM launch option for launching an IM chat session with the at least one recipient of the email message**” as recited in claim 1. More specifically, *Ertugrul* discloses “[b]y sending the e-mail message, the sender pre-registers the recipient (‘Eric Yee’ (212)) for the Instant Messaging service with a generic numbered screen name” (page 3, paragraph [0035]). As illustrated in the excerpt, *Ertugrul* appears to disclose that, prior to receiving the email, the recipient is not registered for the Instant Messaging service. As such, *Ertugrul* fails to even suggest and, in fact, teaches away from “providing an **email compose interface for composing an email** message... the email compose interface including an **IM launch option for launching an IM chat session with the at least one recipient of the email message**” claim 1. For at least this reason, claim 1 is allowable.

Further, *Lehman* fails to overcome the deficiencies of *Ertugrul*. More specifically, *Lehman* discloses “The Essence of Chat” (page 1, line 12). As *Lehman* discloses “The Essence of Chat” and fails to disclose any email compose interface, *Lehman* is different than “providing an **email compose interface for composing an email** message... the email compose interface including an **IM launch option for launching an IM chat session with the at least one recipient of the email message**” as recited in claim 1. For at least this additional reason, claim 1 is allowable.

B. Claim 9 is Allowable Over *Ertugrul* in view of *Lehman*

The Office Action indicates that claim 9 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over of U.S. Publication Number 2002/0087645 (“*Ertugrul*”) in view of Wayback machine:

<http://web.archive.org/web/19970125101157/http://www.albion.com/ngmsn/07chat-sample.html> (“*Lehman*”). Applicants respectfully traverse this rejection for at least the reason that *Ertugrul* in view of *Lehman* fails to disclose, teach, or suggest all of the elements of claim 9. More specifically, claim 9 recites:

A computer-readable storage medium encoded with instructions for execution, comprising:

computer-readable code adapted to instruct a programmable device to **provide an email compose interface** for composing an email message, the email compose interface configured to designate at least one email recipient, the email compose interface including an email send option for sending the email message to the email recipient, the email compose interface including **an IM launch option for launching an IM chat session with the at least one recipient of the email message**;

computer-readable code adapted to instruct a programmable device to receive an indication to launch an IM chat session with the at least one email recipient of the email message from the email compose interface;

computer-readable code adapted to instruct a programmable device to receive an indication to save an IM chat transcript of the IM chat session; and

computer-readable code adapted to instruct a programmable device to save the IM chat transcript in response to receiving the indication to save the IM chat transcript.

(emphasis added)

Applicants respectfully submit that claim 9 is allowable for at least the reason that *Ertugrul* in view of *Lehman* fails to disclose, teach, or suggest a “computer-readable storage medium encoded with instructions for execution, comprising... computer-readable code adapted to instruct a programmable device to **provide an email compose interface** for composing an email message, the email compose interface configured to designate at least one email recipient, the email compose interface including an email send option for sending the email message to the email recipient, the email compose interface including **an IM launch option for launching an IM chat session with the at least one recipient of the email message**” as recited in claim 9. More specifically, *Ertugrul* discloses “FIG. 2 illustrates the body of a representative email message 200 received by an email recipient” (page 3, paragraph [0034]). For at least the reason that *Ertugrul* fails to disclose “computer-readable code adapted to instruct a programmable device to **provide an email compose interface**... the email compose interface including **an IM launch option for launching an IM chat session with the at least one recipient of the email message**” claim 9 is allowable.

Applicants additionally submit that *Ertugrul* fails to even suggest “computer-readable code adapted to instruct a programmable device to **provide an email compose interface**... the email compose interface including **an IM launch option for launching an IM chat session with the at least one recipient of the email message**” as recited in claim 9. More specifically, *Ertugrul* discloses “[b]y sending the e-mail message, the sender pre-registers the recipient (‘Eric Yee’ (212)) for the Instant Messaging service with a generic numbered screen name” (page 3, paragraph [0035]). As illustrated in the excerpt, *Ertugrul* appears to disclose that, prior to receiving the email, the recipient is not registered for the Instant Messaging service. As such, *Ertugrul* fails to even suggest and, in fact, teaches away from “computer-readable code adapted to instruct a programmable device to **provide an email compose interface**... the email

compose interface including ***an IM launch option for launching an IM chat session with the at least one recipient of the email message***" claim 9. For at least this reason, claim 9 is allowable.

Further, *Lehman* fails to overcome the deficiencies of *Ertugrul*. More specifically, *Lehman* discloses "The Essence of Chat" (page 1, line 12). As *Lehman* discloses "The Essence of Chat" and fails to disclose any email compose interface, *Lehman* is different than "computer-readable code adapted to instruct a programmable device to ***provide an email compose interface... the email compose interface including an IM launch option for launching an IM chat session with the at least one recipient of the email message***" as recited in claim 9. For at least this additional reason, claim 9 is allowable.

C. Claim 16 is Allowable Over *Ertugrul* in view of *Lehman*

The Office Action indicates that claim 16 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over of U.S. Publication Number 2002/0087645 ("*Ertugrul*") in view of Wayback machine:

<http://web.archive.org/web/19970125101157/http://www.albion.com/ngmsn/07chat-sample.html> ("*Lehman*"). Applicants respectfully traverse this rejection for at least the reason that *Ertugrul* in view of *Lehman* fails to disclose, teach, or suggest all of the elements of claim 16. More specifically, claim 16 recites:

A system for saving a transcript of instant messaging (IM) chat sessions, the system comprising:

means for ***providing an email compose interface*** for composing an email message, the email interface configured to designate at least one email recipient, the email compose interface including an email send option for sending the email message to the email recipient, the email compose interface including ***an IM launch option for launching an IM chat session with the at least one recipient of the email message***;

means for receiving an indication to launch an IM chat session with the at least one email recipient of the email message from the email compose interface;

means for receiving an indication to save an IM chat transcript of the IM chat session; and

means for saving the IM chat transcript in response to receiving the indication to save the IM chat transcript.
(emphasis added)

Applicants respectfully submit that claim 16 is allowable for at least the reason that *Ertugrul* in view of *Lehman* fails to disclose, teach, or suggest a “system for saving a transcript of instant messaging (IM) chat sessions, the system comprising... means for **providing an email compose interface** for composing an email message, the email interface configured to designate at least one email recipient, the email compose interface including an email send option for sending the email message to the email recipient, the email compose interface including **an IM launch option for launching an IM chat session with the at least one recipient of the email message**” as recited in claim 16. More specifically, *Ertugrul* discloses “FIG. 2 illustrates the body of a representative email message 200 received by an email recipient” (page 3, paragraph [0034]). For at least the reason that *Ertugrul* fails to disclose “means for **providing an email compose interface** for composing an email message... the email compose interface including **an IM launch option for launching an IM chat session with the at least one recipient of the email message**” claim 16 is allowable.

Applicants additionally submit that *Ertugrul* fails to even suggest “means for **providing an email compose interface** for composing an email message... the email compose interface including **an IM launch option for launching an IM chat session with the at least one recipient of the email message**” as recited in claim 16. More specifically, *Ertugrul* discloses “[b]y sending the e-mail message, the sender pre-registers the recipient (‘Eric Yee’ (212)) for the Instant Messaging service with a generic numbered screen name” (page 3, paragraph [0035]). As illustrated in the excerpt, *Ertugrul* appears to disclose that, prior to receiving the email, the recipient is not registered for the Instant Messaging service. As such, *Ertugrul* fails to even suggest and, in fact, teaches away from “means for **providing an email compose interface** for composing an email message... the email compose interface including **an IM launch option for**

launching an IM chat session with the at least one recipient of the email message" claim

16. For at least this reason, claim 16 is allowable.

Further, *Lehman* fails to overcome the deficiencies of *Ertugrul*. More specifically, *Lehman* discloses "The Essence of Chat" (page 1, line 12). As *Lehman* discloses "The Essence of Chat" and fails to disclose any email compose interface, *Lehman* is different than "means for ***providing an email compose interface*** for composing an email message... the email compose interface including ***an IM launch option for launching an IM chat session with the at least one recipient of the email message***" as recited in claim 16. For at least this additional reason, claim 16 is allowable.

D. Claim 17 is Allowable Over *Ertugrul* in view of *Lehman*

The Office Action indicates that claim 17 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over of U.S. Publication Number 2002/0087645 ("*Ertugrul*") in view of Wayback machine:

<http://web.archive.org/web/19970125101157/http://www.albion.com/ngmsn/07chat-sample.html>

("Lehman"). Applicants respectfully traverse this rejection for at least the reason that *Ertugrul* in view of *Lehman* fails to disclose, teach, or suggest all of the elements of claim 17. More specifically, claim 17 recites:

A system for saving a transcript of instant messaging (IM) chat sessions, the system comprising:

a provide component configured to ***provide an email compose interface*** for composing an email message, the email compose interface configured to designate at least one email recipient, the email compose interface including an email send option for sending the email message to the email recipient, the email compose interface ***including an IM launch option for launching an IM chat session with the at least one recipient of the email message***;

a first receive component configured to receive an indication to launch an IM chat session with the at least one recipient of the email message from the email compose interface;

a second receive component configured to receive an indication to save an IM chat transcript of the IM chat session; and

a save component configured to save the IM chat transcript in response to receiving the indication to save the IM chat transcript.
(emphasis added)

Applicants respectfully submit that claim 17 is allowable for at least the reason that *Ertugrul* in view of *Lehman* fails to disclose, teach, or suggest a “system for saving a transcript of instant messaging (IM) chat sessions, the system comprising... a provide component configured to **provide an email compose interface** for composing an email message, the email compose interface configured to designate at least one email recipient, the email compose interface including an email send option for sending the email message to the email recipient, the email compose interface **including an IM launch option for launching an IM chat session with the at least one recipient of the email message**” as recited in claim 17. More specifically, *Ertugrul* discloses “FIG. 2 illustrates the body of a representative email message 200 received by an email recipient” (page 3, paragraph [0034]). For at least the reason that *Ertugrul* fails to disclose “a provide component configured to **provide an email compose interface** for composing an email message... the email compose interface **including an IM launch option for launching an IM chat session with the at least one recipient of the email message**” claim 17 is allowable.

Applicants additionally submit that *Ertugrul* fails to even suggest “a provide component configured to **provide an email compose interface** for composing an email message... the email compose interface **including an IM launch option for launching an IM chat session with the at least one recipient of the email message**” as recited in claim 17. More specifically, *Ertugrul* discloses “[b]y sending the e-mail message, the sender pre-registers the recipient (‘Eric Yee’ (212)) for the Instant Messaging service with a generic numbered screen name” (page 3, paragraph [0035]). As illustrated in the excerpt, *Ertugrul* appears to disclose that, prior to receiving the email, the recipient is not registered for the Instant Messaging service. As such, *Ertugrul* fails to even suggest and, in fact, teaches away from “a provide

component configured to **provide an email compose interface** for composing an email message... the email compose interface **including an IM launch option for launching an IM chat session with the at least one recipient of the email message**" claim 17. For at least this reason, claim 17 is allowable.

Further, *Lehman* fails to overcome the deficiencies of *Ertugrul*. More specifically, *Lehman* discloses "The Essence of Chat" (page 1, line 12). As *Lehman* discloses "The Essence of Chat" and fails to disclose any email compose interface, *Lehman* is different than "a provide component configured to **provide an email compose interface** for composing an email message... the email compose interface **including an IM launch option for launching an IM chat session with the at least one recipient of the email message**" as recited in claim 17. For at least this additional reason, claim 17 is allowable.

E. Claims 2, 7, 10, 14, 18, and 22 are Allowable Over *Ertugrul* in view of *Lehman*

The Office Action indicates that claims 2, 7, 10, 14, 18, and 22 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Publication Number 2002/0087645 ("*Ertugrul*") in view of Wayback machine: <http://web.archive.org/web/19970125101157/http://www.albion.com/ngmsn/07chat-sample.html> ("*Lehman*"). Applicants respectfully traverse this rejection for at least the reason that *Ertugrul* in view of *Lehman* fails to disclose, teach, or suggest all of the elements of claims 2, 7, 10, 14, 18, and 22. More specifically, dependent claims 2 and 7 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 1. Dependent claims 10 and 14 are believed to be allowable for at least the reason that they depend from allowable independent claim 9. Further, dependent claims 18 and 22 are believed to be allowable for at least the reason that they depend from allowable independent claim 17. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

F. Claims 3 – 5, 11 – 12, and 19 – 20 are Allowable Over *Ertugrul* and *Lehman* in view of *Kusuda*

The Office Action indicates that claims 3 – 5, 11 – 12, and 19 – 20 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Publication Number 2002/0087645 ("*Ertugrul*") and Wayback machine:

<http://web.archive.org/web/19970125101157/http://www.albion.com/ngmsn/07chat-sample.html> ("*Lehman*") in view of U.S. Publication Number 2003/0088623 ("*Kusuda*"). Applicants respectfully traverse this rejection for at least the reason that *Ertugrul* and *Lehman* in view of *Kusuda* fails to disclose, teach, or suggest all of the elements of claims 3 – 5, 11 – 12, and 19 – 20. More specifically, dependent claims 3 – 5 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 1. Dependent claims 11 and 12 are believed to be allowable for at least the reason that they depend from allowable independent claim 9. Further, dependent claims 19 and 20 are believed to be allowable for at least the reason that they depend from allowable independent claim 17. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

G. Claims 6, 13, and 21 are Allowable Over *Ertugrul*, *Lehman* and *Kusuda* in view of *Gusler*

The Office Action indicates that claims 3 – 5, 11 – 12, and 19 – 20 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Publication Number 2002/0087645 *Ertugrul et al.* ("*Ertugrul*"), *Lehman* (Wayback machine:

<http://web.archive.org/web/19970125101157/http://www.albion.com/ngmsn/07chat-sample.html>), hereinafter ("*Ertugrul*") and U.S. Publication Number 2003/0088623 ("*Kusuda*") in view of U.S. Publication Number 2003/0105815 *Gusler et al.* ("*Gusler*"). Applicants respectfully traverse this rejection for at least the reason that *Ertugrul*, *Lehman* and *Kusuda* in view of *Gusler* fails to disclose, teach, or suggest all of the elements of claims 6, 13, and 21. More

specifically, dependent claim 6 is believed to be allowable for at least the reason that this claim depends from allowable independent claim 1. Dependent claim 13 is believed to be allowable for at least the reason that it depends from allowable independent claim 9. Further, dependent claim 21 is believed to be allowable for at least the reason that it depends from allowable independent claim 17. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

H. Claims 8, 15, and 23 are Allowable Over Ertugrul and Lehman in view of Gusler

The Office Action indicates that claims 8, 15, and 23 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Publication Number 2002/0087645 *Ertugrul et al.* ("*Ertugrul*") and *Lehman* (Wayback machine: <http://web.archive.org/web/19970125101157/http://www.albion.com/ngmsn/07chat-sample.html>), hereinafter ("*Ertugrul*") in view of U.S. Publication Number 2003/0105815 *Gusler et al.* ("*Gusler*"). Applicants respectfully traverse this rejection for at least the reason that *Ertugrul* and *Lehman* in view of *Gusler* fails to disclose, teach, or suggest all of the elements of claims 8, 15, and 23. More specifically, dependent claim 8 is believed to be allowable for at least the reason that this claim depends from allowable independent claim 1. Dependent claim 15 is believed to be allowable for at least the reason that it depends from allowable independent claim 9. Further, dependent claim 23 is believed to be allowable for at least the reason that it depends from allowable independent claim 17. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

II. Allegedly Inherent Subject Matter

A. Claims 6, 13, and 21

In addition, in rejecting claims 6, 13, and 21, the Office Action states “converting the IM chat transcript to an email message is inherent by having the ability to provide the transcripts in a variety of different ways to including free text, encrypted text, and binary files readable by any other standard text processing software” (OA page 11, element 5). Applicants respectfully traverse the finding of inherency. It is well established that “[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In Re Anthony J. Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2D (BNA) 1949, 1950-51 (Fed. Cir. 1999).

Applicants respectfully submit that the Office Action fails to adequately establish that the subject matter of claims 6, 13, and 21 is necessarily present. As the Office Action fails to provide any extrinsic evidence that makes clear that the missing descriptive matter is necessarily present, Applicants respectfully submit that inherency has not been established. In accordance with *In re Robertson*, Applicants traverse the inherency finding, and submit that claims 6, 13, and 21 are allowable over the cited art.

B. Claims 8, 15, and 23

In addition, in rejecting claims 8, 15, and 23, the Office Action states "saving the IM chat transcript as an email message is inherently a step prior to sending an email message to a recipient" (OA page 11, element 6). Applicants respectfully traverse the finding of inherency. It is well established that "[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In Re Anthony J. Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2D (BNA) 1949, 1950-51 (Fed. Cir. 1999).

Applicants respectfully submit that the Office Action fails to adequately establish that the subject matter of claims 8, 15, and 23 is necessarily present. As the Office Action fails to provide any extrinsic evidence that makes clear that the missing descriptive matter is necessarily present, Applicants respectfully submit that inherency has not been established. In accordance with *In re Robertson*, Applicants traverse the inherency finding, and submit that claims 6, 15, and 23 are allowable over the cited art.

CONCLUSION

In light of the foregoing remarks and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and Official Notice, or statements interpreted similarly, should not be considered well-known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

/afb/

Anthony F. Bonner Jr. Reg. No. 55,012

**THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.**
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500
Customer No.: **38823**